REMARKS

Double Patenting

Claims 40-89 are rejected under judicially created doctrine of obviousness-type double patenting over claims 1-23 of U.S. Patent No. 6,324,264.

In response, without acquiescing to the double patenting rejection and only to expedite the prosecution of this case, Applicants hereby file a Terminal Disclaimer to overcome the rejection.

Rejections Under 35 U.S.C. 102

Claims 40, 41, 45, 46, 56, 57, 61, 69, 70, 73, and 77 are rejected as being anticipated by U.S. Patent No. 5,483,586 of Sussman.

Claim 40 recites a method of establishing a communications call, which comprises enabling an A party to select a B party from a database using an interactive device connected to a public network, where the public network comprises an *Internet* messaging network. The method further calls for utilizing the *Internet* messaging network to access called address data for the B party from a public directory of said public network in response to selecting the B party, and sending the called address data for the B party and calling address data for the A party to a connection module of said public network. A call can then be established between the A and B parties over the public network using the connection module and the called and calling address data.

Sussman discloses generally a method for automatically updating a subscriber's local telephone directory via periodic downloads from a central database. More specifically, a central telephone directory service provider maintains a central database. The service provider can transmit, via a conventional common carrier telecommunications switching network (CCTSN), updated directories to a subscriber based on a pre-defined update schedule, e.g., weekly or monthly.

As noted in Applicants' previous response, Sussman employs a conventional switching network (i.e., CCTSN), and not an Internet messaging network, for transmitting the directory information to a subscriber. In this Office Action, the Examiner disagrees with this characterization

of the CCTSN employed in Sussman. In particular, the Examiner indicates that the disclosures in Sussman that a user can access telephone subscribers list in on-line directories and that the subscribers lists are downloaded into computer make it "clear that Sussman employs an Internet messaging network for transmitting the directory information to a subscriber." Applicants respectfully disagree for the following reasons. The fact that data is downloaded from the service provider central directory to the subscriber directory does not necessarily indicate that a connectionless, packet-switched network, such as the Internet, is utilized. In other words, the download can also be achieved by a connection-oriented network that operates by "forming a dedicated connection or circuit between two points." See, page 18, Internetworking with TCP/IP Principles, Protocols, And Architectures, Douglas E. Comer 2000 (a copy of this page is enclosed for the Examiner's convenience). There is no indication in Sussman that his CCTSN is a packet-switched network.

The following passage of Sussman further buttresses Applicants' contention that in Sussman central directory data is downloaded onto a user's local directory via conventional means:

> As mentioned previously, the preferred embodiment of the invention allows the user to select the date and time at which the directory updates are received. For example, a business subscriber 8 could determine to receive directory updates on the last day of each month at 2:00 AM. On the other hand, a residential subscriber 5 could select to receive updates on June 30 and December 30 at 11:00 PM each year. This information is stored in the Subscriber Information Database 2. T*his feature minimizes the inconvenience of the directory update procedure tying up the subscriber's telephone line, as well as to capitalize on any off-peak-hour discount that the CCTSN 4 may offer subscribers in using the network 4.* [Emphasis Added] col. 3, lines 13-26.

Moreover, even if one were to agree with the Examiner, *arguendo*, that Sussman employs the Internet for downloading directory data from the service provider to the subscriber, its method differs fundamentally from that recited in claim 40. In particular, in Sussman, the user searchers the *downloaded local* directory data for a party's telephone number, rather than accessing the central database. In other words, in Sussman, in response to each user's search query, the service provider's central directory is not accessed. Rather, a search of the *downloaded directory data* is performed. In contrast, claim 1 recites that in response to the selection of the B party, the Internet

messaging network is utilized to access the called address data for the B party. As such, the claimed method provides a number of advantages. For example, it obviates the need to store a large quantity of data on the user's side, eliminates the need for tedious downloads to each user and allows access to real-time (most current) address data.

Accordingly, claim 40 distinguishes patentably over Sussman.

Similar reasoning applies to establish that claims 41, 45, 46, 56, 57, 61, 69, 70, 73, and 77 distinguish patentably over Sussman.

Rejections Under 35 U.S.C. 103

Claims 40, 41, 42/40, 42/41, 43-46, 47/40, 47/41, 47/45, 47/46, 48, 49, 56-58, 59/56, 59/57, 60, 61, 62/60, 62/61, 63, 64/60, 65/60, 66/61, 67/60, 67/61, 68-71, 72/69, 72/70, 73-87, 88/40, 88/41, 88/45, 88/46, 88/73, 89/40, 89/41, 89/45, 89/46, and 89/73 are rejected as being unpatentable over U.S. Patent No. 5,884,032 of Bateman in view of Sussman.

Bateman is directed to methods and systems for automatically providing a telephone connection between a customer utilizing an organization's multimedia services to the organization's Automatic Call Distribution (ACD) agent. In a typical session, a customer utilizes a browser to access a web server of the organization to view HTML pages containing information regarding the organization's products and services. The customer can choose a "Live Help" option provided within a viewed HTML page to prompt a HTML form to pop up. The pop-up HTML form asks the customer for a telephone number at which the customer can be reached. Further, the URL of the page that the customer was viewing is automatically entered in the form. The customer's calling information is sent to a HOTLIST database that feeds an outbound dialing system. The agent can view the HTML page associated with the customer's URL before or while a call is automatically made to connect the agent to the customer.

In Bateman, a customer does not select a particular agent from a database. Rather, the customer submits an HTML form to the call center in which the customer's calling information is provided, and the outbound dialing system, which maintains a HOTLIST of customers to be called,

selects an agent for calling the customer. Nonetheless, the Examiner states that it would have been obvious to one of ordinary skill in the art to modify Bateman to select a particular agent. The Examiner indicates that the motivation for the modification is "to get a particular agent who can assist him instead of waiting for a certain period of time in a queue."

Such a modification would, however, lead to certain disadvantages. While the Bateman system allows the customer to request a call-back at a time suitable for the customer, such a modification would require the customer to wait on a queue until the desired agent is available. In particular, there is no guarantee that a particular agent selected by the customer would be available at the time the customer selects that agent. In other words, it would lead to a system similar to those that Bateman criticizes in its background. Further, such a modification would not allow an agent to consider a customer's inquiry off-line and call back the customer only when the agent can answer the customer's question.

Thus, claim 40 distinguishes patentably over the cited art. Similar reasoning applies to establish that independent claims 41, 45, 46, and 49 are also patentable. Further, each of the claims 42, 43, 44, 47, 48, and 49 depends on at least one of these claims, and hence is also patentable.

With regard to claim 56, neither Bateman nor Sussman teaches an interface stored on an interactive device connected to a public network, which includes code for allowing an A party to select a B party from displayed B party data as well as code for transmitting to the public network party data corresponding to the selected B party and A party, where the public network accesses called address data for the B party in a public directory by utilizing an Internet messaging network. In particular, in Bateman, the customer does not select an agent. Further, in Sussman, the subscriber searches the *downloaded* directory for a party's telephone number, rather than selecting the party via an interactive display device and sending the party data, via the Internet, to a public directory such that the public directory would access the party's telephone number.

Hence, claim 56 is believed to be patentable over the combined teachings of Bateman and Sussman.

In Paragraph 12, the Office Action rejects claims 40, 41, 45, 46, 50, 51, 56, 57, 60, 61, 69, 70, 73 and 77 as being unpatentable over U.S. Patent No. 4,979,206 of Padden in view of Sussman. Applicants respectfully traverse the rejections for the following reasons.

Neither Padden nor Sussman teaches utilizing *Internet messaging network* to access the called address data of a party from a public directory of the network in response to the selection of that party by another party. In particular, the voice and data switching network in Padden is not an Internet messaging network. Further, as discussed in detail above, there is no indication in Sussman that the CCTSN is an Internet messaging network. Moreover, in Sussman, in response to a search query from the subscriber, a searched party's telephone number is looked up in the subscriber's *local* directory that had been previously downloaded from the central database; it is not accessed in the central database via the Internet, or for that matter via CCTSN. In contrast, claim 40 recites that in response to selecting the B party, the Internet messaging network is utilized to access called address data for the B party from a public directory of that network.

Thus, claim 40 distinguishes patentably over the combined teachings of Padden and Sussman. Similar reasoning applies to establish that independent claims 41, 45, 46 are also patentable over the cited art.

With regard to claim 50, Padden does not display a B party from a database to an A party. Further, Sussman does not provide a link which can be activated to send party data corresponding to a party selected by the subscriber from a display to a public network, where the public network accesses called address data of the B party in a public directory via an Internet messaging network. In fact, as noted above, in Sussman, the subscriber utilizes the directory data that has already been downloaded to its local directory to search for a party's telephone number; it does not send the party's information to the central database to obtain its telephone number.

Hence, claim 50 distinguishes patentably over cited art. Similar reasoning applies to establish that claims 51, 56, 57, 60, 61, 69, 70, 73, and 77 are also patentable.

CONCLUSION

In view of the above amendments and remarks, Applicants respectfully request reconsideration and allowance of the application. The Examiner is invited to call the undersigned at (617) 439-2514 if there are any questions.

Respectfully submitted,

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